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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/511,447	02/23/2000	David Elworthy	1263.0899	3320
5514	7590	01/20/2004		
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
			EXAMINER EDOUARD, PATRICK NESTOR	
			ART UNIT 2654	PAPER NUMBER 12

DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/511,447

Applicant(s)
ELWORTHY

Examiner
Patrick N. Edouard

Art Unit
2654



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 16, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 2654

DETAILED ACTION

1. This Office Action is in response to communication filed 10/16/03 (paper #10). Claims 1-22 and new claim 23 are pending.

Response to Arguments

2. Applicant's arguments filed 10/16/03 have been fully considered but they are not persuasive because of the following reasons:

In response to Applicant's argument that the prior art does not teach: "when there are unmatched units in the reference data, the generating means generates context data in the form of one or more unmatched units in the reference data...". The examiner cannot concur. In fact, the limitation upon which the Applicant relied is rejected under 112 para. 1st and 2nd for not being described in the specification; and also this limitation renders the claim to be vague and indefinite. Therefore, the examiner rejected the claims based on the broad interpretation of a limitation that is not described in the specification.

In response to Applicant's request for a prior art that support the examiner position for the 103 rejection where Official Notice was taken for the feature that recited forming output data a layered hierarchical structure identifying sets of data by their context data. The examiner would like to cite Keinberger (6,062,074) for teaching a information retrieval system wherein the texts are aggregated into sub-groups and the resulting sub-groups are then displayed to the user in a hierarchical display to illustrate the relationships among the texts.

Art Unit: 2654

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation “ matching means for searching for and identifying any matches between the units of the input query and the units of the data so as to generate reference data” is not described in the specification to enable one skilled in the art on how to use or make it. In fact, the specification on page 12, lines 27 to page 12, lines 2 and 11-27 described “ a set of reference data in the data to be searched is selected and parsed” and “the data generated as a result of the matching operation and the using the finite state parser is data indicating a sequence of words...”. The Applicant is advised to point out where this limitation can be found in the specification if believed otherwise.

5. Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 2654

The limitation “matching means for searching for and identifying any matches between the units of the input query and the units of the data so as to generate reference data” is vague and indefinite since it does not set the metes and bounds of the claim.

6. Claims 1-23 recite the limitation "reference data" in lines 8 and 10. There is insufficient antecedent basis for this limitation in the claim, since this limitation “as to generate reference data” was not described in the specification.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Art Unit: 2654

8. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Ortega et al (6,144,958).

As per claim 1, Ortega et al teach a search apparatus for searching for data in the form of units of a natural language, (figure 4)the apparatus comprising:

“Interface means for receiving an input query in the form of a natural language and for outputting ...) (his process search query received from user);

“Matching means for searching for and identifying any matches between the input ...) (Col. 8, lines 27-32);

“Generating means for where there are unmatched units in the query or the data, generating context data in the form of one or more unmatched units of the query...having a predefined linguistic relationship to one of the or each matched units) (col. 8, lines 39-63, the query server invokes its spelling correction to attempt to correct the non-matching terms . The term correction process by retrieving the related term list for each matching term from the correlation table.(Reads on predefined linguistic relationship).

As per claims 2-5, Ortega et al teaches wherein said generating means is adapted to generate the ...modification relationship to the respective matches units (col. 8, lines 12-63, the spell correlation retrieves the related terms list for each matching term from the correlation table).

Art Unit: 2654

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 6 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ortega et al (6,144,958).

It is noted that Ortega et al teach the claimed invention but does not explicitly teach forming means is adapted to form ...said matched units associated with respective said unmatched units having predefined linguistic relationship to respective matched units. However, Ortega et al teach at col. 8, lines 27-38, "appalatian" does not exist as a subject word in the bibliographic database 40. Therefore, one having ordinary skill in the art at the time the invention was made would recognize that the non-matching units have linguistic relationship with the matching units such subject/verb/object with the motivation of notifying to the user why certain units were unmatched since it would allow the user to make modifications to the query that would increase the likelihood that the query result will contain items that are of interest to the user.

It is noted that Ortega et al teach the claimed invention but does not explicitly teach wherein said forming means is adapted to form output data as a layered hierarchical structure identifying sets of data by their context data. However, this feature is well known in the art. Therefore, one having ordinary skill in the art at the time the invention was made would have

Art Unit: 2654

found it obvious to output the data as taught by Ortega as a hierarchical structure because it would allow a user to efficiently and intuitively identify a document (i.e. topic) as being a subtopic of a superior topic.

11. Claims 9-23 are the same in scope and content as claims 1-8 above and therefore are rejected under the same rationale.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231 or faxed to:

Art Unit: 2654

(703) 308-9051, (for formal communications intended for entry) Or:

(703) 305-9508 (for informal or draft communications, please label "PROPOSED" or "DRAFT") Hand-delivered responses should be brought to Crystal Park 11, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick N. Edouard whose telephone number is (703) 308-6725. The examiner can normally be reached on Tuesday-Friday from 07:30 a.m.-6:00 p.m.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (703) 305-4379.

The facsimile phone number for this Art Unit is (703) 872-9314. Alternatively, facsimile messages may be sent directly to (703) 305-9644 where they will be stored in the examiner's voice mailbox (telling the examiner that a fax was received) and be automatically printed (i.e. - no delay by the examiner).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Patrick N. Edouard

January 10, 2004



PATRICK N. EDOUARD
PATENT EXAMINER